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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,566	10/23/2003	Gopal S. Revankar	007300-084	5983

21839 7590 06/20/2006

BUCHANAN INGERSOLL PC  
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)  
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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/690,566

Applicant(s)

REVANKAR ET AL.

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-28,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 11-28 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-10, 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/23/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **THIRD OFFICE ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 16, 2006 has been entered.

### ***Election/Restrictions***

2. Applicant has requested rejoinder of the method claims once article claim 1 is found allowable. Pursuant to the procedures set forth in MPEP § 821.04(B), claims directed to the method, previously withdrawn from consideration as a result of a restriction requirement, will be rejoined and fully examined for patentability under 37 CFR 1.104 if containing all the limitations of article claim 1 at the time of allowance. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 will no longer be applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-2, 5-10 and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of copending U.S.

Patent Application Serial No. 11/171,193 in view of Amano (U.S. Patent 6,414,258). Although

the conflicting claims are not identical, they are not patentably distinct from each other because

the claims to the copending application are drawn to a track pin bushing joint with a wear-

resistant coating comprising an alloy comprising at least 60 weight % iron, cobalt, nickel or

alloys thereof and the claims of the pending application are drawn to a sprocket with a wear-

resistant coating comprising an alloy comprising at least 60 weight % iron, nickel or alloys

thereof. In addition, U.S. Patent Application Serial No. 11/171,193 claims induction hardening

(e.g. claim 39). As evidenced by Amano (e.g. see first paragraph of column 1; Figure 37),

applying hard coatings to both the bushings and the sprockets of endless track drive mechanism

is conventional in the art since sprocket gear wheels contact track bushings in endless track drive

mechanisms. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made that both the sprockets and the track bushing joints of an endless track drive mechanism should be surfaced with of hard materials having compatible wear properties so that neither the track bushing nor the sprocket limit the service life of the endless track drive mechanism. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-2 and 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Although the specification provides support for induction hardening after metallurgically bonding the base metal part and the wear and corrosion-resistant coating (e.g. see page 14, lines 1-7), it is not clear in independent claim 1 that both the base steel member *and* the coating are subjected to the induction hardening treatment as disclosed in the specification. It is suggested that claim 1 be amended to have similar language as that in new claim 32 which more clearly indicates that the induction hardening occurs after the wear coating has been applied.

***Response to Arguments***

8. Applicant's arguments filed May 12, 2006 have been fully considered but they are not persuasive with regards to the pending rejections.

9. Regarding the provisional rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending U.S. Patent Application Serial No. 11/171,193 in view of Amano (U.S. Patent 6,414,258), applicant has indicated that a terminal disclaimer to obviate the provisional rejection would be considered upon the indication of allowable subject matter in this application.

10. Applicant's arguments regarding the 35 U.S.C. 103 rejections based on Amano (U.S. Patent 6,414,258) have resulted in the withdrawal of these rejections since the induction heating process suggested by Amano treats the inner surface of the bushing and not the outer coated surface. Applicant argues that the induction hardening of the present invention occurs after the wear coating is fused for improved strength characteristics whereas Amano does not teach or suggest such an embodiment. In order to ensure that the claim limitations are commensurate with this argument and also clarify that the induction hardening occurs after metallurgically bonding the base metal part and the wear and corrosion-resistant coating (e.g. see specification, page 14, lines 1-7), it is suggested that claim 1 be amended to have similar language as that in new claim 32 which more clearly indicates that the induction hardening occurs after the wear coating has been applied (e.g. see rejection under 35 U.S.C. 112, second paragraph, above).

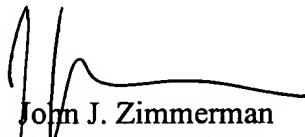
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***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547.

The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
June 12, 2006